



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,016	04/20/2001	Yukihiro Kiuchi	NE+99P237A	9360

466 7590 07/26/2005

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,016

Applicant(s)

KIUCHI ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-38 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) 26-33, 38, 44 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-37, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

1. This is responsive to the Request for Continued Examination and amendment filed June 8, 2005. Claims 26-33, 38, 44 and 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 29, 2003.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34-37, 45 and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

2. Examples 18-20 of Table 5 on page 47 shows weight ratios of tetraphenylethane epoxy resin 3:biphenyl aralkyl epoxy resin 2 (according to page 25) of only 1:5 which does not support higher ratios as defined by the claimed phrase "no less than 1/5."

The text section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 34-37, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 268219 in view of Japanese Patent Noş. 5738814 and 58-150581.

3. Japanese '219 (page 6, paragraph 33) espouses at least 30% by weight of other epoxy resins which is embraced by the claimed level of at least 20% by weight of the epoxy resin blend. It would have been obvious to employ the tetraphenylethane epoxy resin of Japanese '814 and '581 as the other epoxy resin of Japanese '219 in an amount of at least 30% by weight in order to enhance the heat distortion temperature (Japanese '814, abstract, the last three lines).

The arguments filed June 8, 2005 have been considered but are unpersuasive.

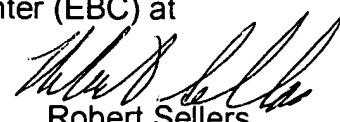
4. The claims necessitate that "said composition comprises no flame retardant material nor flame retardant auxiliary" which is met by each of the references. There is no requirement that the epoxy resin composition must be flame retardant without a flame retardant or flame retardant auxiliary. Even if, *arguendo*, the claims are interpreted as such, the combination in Japanese '219 of a phenol-biphenyl aralkyl epoxy resin and phenol-biphenyl aralkyl phenol resin inherently exhibits flame retardancy by virtue of the particular blend of aromatic epoxy resin and phenolic resin curing agent.

Art Unit: 1712

5. The passage on page 1, paragraph 3 of Japanese '219 does not compromise the motivation for incorporating the tetraphenylolthane epoxy resin of Japanese '814 and '581 as the other epoxy resin of Japanese '219. Paragraph 3 of Japanese '219 pertains to the inadequacy of blending a polyfunctional epoxy resin such as a cresol novolak epoxy resin with a bisphenol A epoxy resin as disclosed in previous paragraph 2, lines 5-7. The teachings of Japanese '219 are directed to an improvement with respect to water resistance and mechanical strength over conventional bisphenol A epoxy resin-cresol novolak epoxy resin blends by utilizing a phenol-biphenyl aralkyl epoxy resin. The inclusion of a polyfunctional epoxy resin other than the recognized deleterious cresol novolak epoxy resin such as the tetraphenylolthane epoxy resin of Japanese '814 and '581 is consistent with the objectives of Japanese '219 by enhancing the heat distortion temperature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712

rs

7/21/2005